

## **REMARKS/ARGUMENTS**

Claims 37-40, 42, 43, and 45 are pending in the present application. Claim 38 was canceled; claims 37 and 43 were amended; and no claims were added. The listing of the claims beginning on page 2 of this response replaces all prior versions, and listings, of claims in the application.

Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 101 (Claims 43 and 45)**

The Examiner has rejected claims 43 and 45 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Final Office Action dated February 3, 2010, pp. 2-3. This rejection is respectfully traversed.

In rejecting claims 43 and 45, the Examiner states:

Claim 43 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 43 recites a computer program product that includes a computer readable medium which appears to cover both transitory and non-transitory embodiments. The United States Patent and Trademark Office (USPTO) is required to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

The Examiner suggests that the Applicants add the limitation "non-transitory computer readable storage" to the claim(s) in order to properly render the claims in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification.

Claim 45 is rejected based on its dependency on the rejected base claim 43.

Final Office Action dated February 3, 2010, pp. 2-3.

Claim 43 has been amended to recite, in relevant part, the following:

A computer program product comprising:

a computer readable and tangible storage medium;

a program stored in the computer readable and tangible storage medium adapted to cause a computer connected to a plurality of remote computers and to an instant messaging service by a network, wherein the instant messaging service is adapted for sending and receiving a plurality of text messages in real time between a plurality of users on the plurality of remote computers, to perform steps comprising:

Claim 43 now recites a “computer readable and tangible storage medium”, thereby precluding a signal. Applicants respectfully decline to use “non-transitory” because such a term may be construed to cover volatile memory such as random access memory.

## **II. 35 U.S.C. § 103, Obviousness (Claim 37)**

The Examiner has rejected claim 37 under 35 U.S.C. § 103 as being unpatentable over Brown et al., U.S. Patent Application Publication No. 2003/0023684 (hereinafter “Brown”), in view of Briggs et al., U.S. Patent No. 7,080,139 (hereinafter “Briggs”), and further in view of Bogard, U.S. Patent Application Publication No. 6,757,365 (hereinafter “Bogard”). Final Office Action dated February 3, 2010, pp. 3-7.

Claim 37 has been amended to incorporate allowable claim 38. Therefore, the rejection of claim 37 under 35 U.S.C. § 103 has been overcome.

## **III. 35 U.S.C. § 103, Obviousness (Claim 39)**

The Examiner has rejected claim 39 under 35 U.S.C. § 103 as being unpatentable over Brown in view of Briggs and Bogard and further in view of St. John et al., U.S. Patent Application Publication No. 2006/0004702 (hereinafter “St. John”). Final Office Action dated February 3, 2010, pp. 7-9.

Claim 39 depends from claim 38, which is allowable due to the incorporation of the allowable subject matter of claim 38. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, the rejection of claim 39 under 35 U.S.C. § 103 has been overcome.

**IV. Allowable Subject Matter (Claims 40 and 42)**

The Examiner has indicated the claims 40 and 42 are allowable. The Examiner is thanked for this indication of allowability.

**V. Allowable Subject Matter – Objection to Claims (Claim 38)**

The Examiner has stated that claim 38 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, the claim has been rewritten to overcome this objection. Furthermore, the Examiner has indicated that claims 43 and 45 (currently rejected under 35 U.S.C. § 101) would also be allowable if the claim text is modified to overcome the rejection under 35 U.S.C. § 101.

Applicants have amended claim 38 to include the limitations of claim 39. Applicants have further amended claim 43 to overcome the rejection under 35 USC § 101. Claim 45 depends from claim 43 and is therefore allowable.

**VI. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,  
/Rudolf O. Siegesmund/

Rudolf O. Siegesmund  
Reg. No. 37,720  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Attorney for Applicants